

REMARKS

In response to the Office action dated December 22, 2010, the Assignee respectfully requests reconsideration. Each of the rejections set forth in the Office Action has been carefully considered and is addressed below. To further the prosecution of this application, amendments have been made in the claims. The claims as presented are believed to be in condition for allowance.

I. Summary of Telephone Interview with Examiner

The Assignee's representatives appreciate the courtesies extended by Examiner Godbold in granting and conducting a telephone interview on Monday, March 7, 2011. The Assignee was represented at the interview by Marc Johannes (Reg. No. 64,978) and Patent Agent Andrew Tibbetts (Reg. No. 65,139). The substance of the telephone interview is summarized herein.

During the telephone interview, the Assignee's representatives presented to the Examiner a general overview of subject matter described in the Specification. U.S. Patent No. 7,139,706 ("Yuschik") was also discussed. The Assignee's representatives and the Examiner also discussed proposals for amendments to some of the claims that would move the prosecution of the case forward toward allowance. During that discussion, the Examiner indicated that the amendments presented herein appeared to overcome the rejections under §103 presented in the Office Action of December 22, 2010, while understandably reserving the right to consider the amendments in more detail upon submission of this Response.

Further details of various topics discussed during the telephone interview with the Examiner are included in the remarks below.

II. Claim Rejection under 35 U.S.C. § 112

Claims 7-12 were rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. In particular, the Office Action alleges that the Specification does not provide written description support for a "computer-readable storage medium" having instructions encoded thereon (Office Action, pages 3-4). The Assignee disagrees, as the Specification as filed provides support for claims 7-12.

The Assignee notes that § 112, first paragraph, does not include an “*in haec verba*” requirement that the terms used in the claims appear precisely in the Specification (MPEP § 2163(I)(B)). Rather, the proper test for written description support under § 112, first paragraph, is whether the Specification describes the claimed invention in “sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention” (MPEP § 2163(I)).

The Specification provides a sufficient description of a “computer-readable storage medium” encoded with instructions. The Specification describes in detail that the processes described in the Specification could be implemented as instructions to be executed by a computer (Specification as filed, ¶¶ 0032-0034). One skilled in the art would understand that, for a computer to execute these instructions, the instructions must be stored in some medium that the computer is able to read. The Specification also describes that information to be read by a computer may be stored in a “storage medium or device” that the computer is able to read (Specification as filed, ¶ 0020).

The Specification’s description that instructions can be stored in a medium able to be read by a computer is sufficient description for one skilled in the art to reasonably conclude that the inventors had possession of a “computer-readable storage medium” encoded with instructions.

Withdrawal of the rejection of claims 7-12 under 35 U.S.C. § 112, first paragraph, is respectfully requested.

III. Claim Rejection under 35 U.S.C. § 101

Claims 7-12 were rejected under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter. In particular, the Office Action alleges that the term “computer-readable storage medium” covers non-statutory subject matter (Office Action, pages 4-5).

Claims 7-12 are statutory under the current policy of the Patent Office. Claims 7-12 recite a “storage medium.” As set out in the “Interim Examination Instructions for Evaluating Subject Matter Eligibility under 35 U.S.C. § 101,” released by the Patent and Trademark Office on August 24, 2009, “a claim to a non-transitory, tangible computer readable storage medium *per se* that possesses structural limitations under the broadest reasonable interpretation standard to qualify as a

manufacture would be patent-eligible subject matter" (Interim Examination Instructions, page 4, section II(A)(c)) (emphasis added).

Further, based on the plain meaning of the term, the term "storage medium" does not include transitory signals. By themselves, transitory signals are merely fleeting, intangible changes in energy states of the materials through which the signals pass. Based on the plain meaning of the word "store," a signal itself, as a fleeting, intangible change in an energy state, cannot "store" anything. The plain meaning of "storage medium" (and the way one of ordinary skill in the art would understand the term) is a medium in which information can be stored. As a transitory signal cannot "store," then a transitory signal cannot be a "storage medium."

Claims 7-12 are therefore directed only to statutory subject matter and do not cover non-statutory subject matter. Withdrawal of the rejections of claims 7-12 under §101 is respectfully requested.

IV. Claim Rejections under 35 U.S.C. § 103

Independent claims 1 and 7 were rejected under 35 U.S.C. § 103(a) as allegedly being obvious over U.S. Patent No. 7,139,706 ("Yuschik") in view of U.S. Patent No. 7,117,153 ("Mahajan"). Independent claim 13 was rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Yuschik in view of Mahajan and further in view of Randic (U.S. Patent No. 6,275,797). While the Assignee believes the claims as previously presented distinguished over the art cited in the rejections of the claims, claims 1, 7, and 13 are amended herein to expedite allowance of this application by further distinguishing over the cited art.

A. Independent Claim 1 Patentably Distinguishes Over The Proposed Modification of Yuschik Based On Mahajan

Independent claim 1, as amended herein, recites a method comprising generating, for a current grammar of the voice portal representing a valid input for a first menu of the voice portal, a test input, providing the test input to the voice portal, and receiving at least one measure of how distinguishable the current grammar is from other grammars of a set of active grammars that are active when the current grammar is active. The set of active grammars includes the current grammar and at least one grammar from a second menu of the voice portal and the at least one

measure comprises at least one measure of how distinguishable the current grammar is from the at least one grammar from the second menu of the voice portal. The method further comprises determining, based at least in part on the at least one measure, whether to modify the current grammar from the first menu to be distinguishable from the at least one grammar from the second menu.

Yuschik describes techniques for ensuring that commands used in a menu system are comfortable for users by accepting “conversational” input from users regarding the commands that should be used to trigger a menu option (Yuschik, col. 7, lines 56-63; col. 10, lines 42-51). The most common input terms are then used as commands (Yuschik, col. 11, line 49, to col. 12, line 5). Yuschik also describes that this style of assigning commands may result in a case where two commands within one submenu are acoustically similar and that, when a pair of commands within one menu are detected to be acoustically similar, one command should be substituted for an alternative to ensure that the commands within each submenu are unique (Yuschik, col. 12, line 35-64). Yuschik suggests, however, that the same commands be used in different menus where possible, such that there would be consistency between menus and users would have to learn fewer commands (Yuschik, col. 12, lines 17-20; col. 13, lines 48-61).

Yuschik therefore describes that when a command within a menu is similar to another command within that same menu, one of those commands should be changed, but that no action should be taken when a command within one menu is similar to a command in a different menu. Yuschik therefore does not describe “determining, based at least in part on the at least one measure, whether to modify the current grammar from the first menu *to be distinguishable from* the at least one grammar from the second menu,” as recited by claim 1 (emphasis added). In contrast to claim 1, Yuschik describes the benefit of a command of one menu *being indistinguishable from* a command of a second menu.

Yuschik therefore does not teach or suggest at least the above quoted limitation in claim 1. The Office Action does not allege that Mahajan discloses this act, nor does Mahajan cure this deficiency. Therefore, even if Yuschik were modified based on Mahajan in the manner proposed by the Office Action, the resulting system would not have performed the above quoted act of “determining” recited by claim 1.

For at least these reasons, claim 1 patentably distinguishes over the proposed modification of Yuschik based on Mahajan and should be allowed. Claims 2-6 depend from claim 1 and patentably distinguish for at least the same reasons. Withdrawal of the rejections of claims 1-6 under §103 is respectfully requested.

B. Independent Claim 7 Patentably Distinguishes Over The Proposed Modification of Yuschik Based On Mahajan

Independent claim 7 recites limitations that would not have been met by the system that would have resulted from the proposed modification of Yuschik based on Mahajan. For reasons that should be appreciated from the foregoing, the resulting system would not have met the limitations of claim 7 regarding “determining, based at least in part on the at least one measure, whether to modify the current grammar from the first menu to be distinguishable from the at least one grammar from the second menu.”

For at least these reasons, claim 7 patentably distinguishes over the proposed modification of Yuschik based on Mahajan. Claims 8-12 depend from claim 7 and patentably distinguish for at least the same reasons. Withdrawal of the rejections of claims 7-12 under §103 is respectfully requested.

C. Independent Claim 13 Patentably Distinguishes Over The Proposed Modification of Yuschik Based On Mahajan and Randic

Independent claim 13 recites limitations that would not have been met by the system that would have resulted from the proposed modification of Yuschik based on Mahajan and Randic. For reasons that should be appreciated from the foregoing, neither Yuschik nor Mahajan teaches or suggests a results analyzer to “determine, based at least in part on the at least one measure, whether to modify the current grammar from the first menu to be distinguishable from the at least one grammar from the second menu,” as recited by claim 13. The Office Action does not allege that Randic describes such a results analyzer, nor does Randic cure the deficiencies of Yuschik and/or Mahajan. Accordingly, even if Yuschik were modified based on Mahajan and Randic in the manner proposed by the Office Action, the resulting system would not have included the results analyzer of claim 13.

For at least these reasons, claim 13 patentably distinguishes over the proposed modification of Yuschik based on Mahajan. Claims 14-16 and new claim 18 depend from claim 13 and patentably distinguish for at least the same reasons. Withdrawal of the rejections of claims 13-16 under §103 is respectfully requested.

V. General Comments on Dependent Claims

As each of the dependent claims depends from a base claim that is believed to be in condition for allowance, the Assignee believes that arguing the further distinguishing features of all of the dependent claims is unnecessary at this time. However, the Assignee does not necessarily concur with the interpretation of the dependent claims as set forth in the Office Action, nor does the Assignee concur that the basis for the rejection of any of the dependent claims is proper. Therefore, the Assignee reserves the right to specifically address in the future the further patentability of the dependent claims not specifically addressed herein.

CONCLUSION

In view of the foregoing amendments and remarks, the application is believed to be in condition for allowance. A notice to this effect is respectfully requested. If the Examiner believes for any reason that the application is not in condition for allowance, he is requested to contact the undersigned to discuss any outstanding issues relating to the allowability of the application.

If this response is not considered timely filed and if a request for an extension of time is otherwise absent, the Assignee hereby requests any necessary extension of time. If there is a fee occasioned by this response, including an extension fee, the Director is hereby authorized to charge any deficiency or credit any overpayment in the fees filed, asserted to be filed or which should have been filed herewith to our Deposit Account No. 23/2825, under Docket No. N0484.70571US00.

Dated: _____

3/21/11

Respectfully submitted,

By _____

Marc S. Johannes, Reg. No. 64,978
Andrew J. Tibbetts, Reg. No. 65,139
WOLF, GREENFIELD & SACKS, P.C.
600 Atlantic Avenue
Boston, Massachusetts 02210-2206
617.646.8000